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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,072	09/27/2005	Henk Kole	NL030362US	4351
24737 7590 01/31/2008 PHILIPS INTELLECTUAL PROPERTY & STANDARDS P.O. BOX 3001 BRIARCLIFF MANOR, NY 10510				
			EXAMINER MOORE, MARGARET G	
			ART UNIT 1796	PAPER NUMBER
			MAIL DATE 01/31/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/551,072

Applicant(s)

KOLE ET AL.

Examiner

Margaret G. Moore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 5, 7, 13 to 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5, 7, 13 to 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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1. The amendment filed 11/19/07 has overcome the rejections made in the office action dated 8/24/07. This amendment, however, has necessitated the following new grounds of rejection.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3, 5 and 13 to 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Havey et al. in view of Clark.

The teachings of Havey et al., and how they correspond to the claimed composition, were noted in previous office actions. See for instance paragraphs 7 and 9 of the previous office action. In an effort to overcome the previous prior art rejections over Havey et al., applicants have required the presence of dimethylmalonic acid in the claimed composition. While Havey et al. teach a medical apparatus comprising a surface which is coated with a sol-gel composition containing the silanes required by claim 1, patentees do not teach dimethylmalonic acid. Column 6, line 39, does teach malonic acid.

Clark teaches coating compositions prepared from the hydrolysis of alkoxysilanes. The top of column 3 teaches that optimum properties are obtained by the addition of an acid compound, to function both as a pH adjusting agent and to affect the rate of silanol condensation. This reference teaches the alternative use of many acid compounds such as glutaric acid and malonic acid, both of which are taught by Havey et al., and dimethylmalonic acid.

It is prima facie obvious to substitute equivalents, motivated by the reasonable expectation that the respective species will behave in a comparable manner or give comparable results in comparable circumstances. The express suggestion to substitute one equivalent for another need not be present to render the substitution obvious.

Thus one having ordinary skill in the art would have found the presence of dimethylmalonic acid in the coating composition of Havey et al. to have been obvious in view of the teachings of Clark, which indicate the functional equivalence of various organic acids. The results of such a substitution would have been predictable, since they are disclosed as being equivalents and the acidic groups in dimethylmalonic acid and malonic acid will be expected to perform in a comparable manner.

4. Claims 1, 3, 5, 7 and 13 to 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schachter in view of Clark.

The teachings of Schachter, and how they correspond to the claimed composition, were noted in previous office actions. See for instance paragraphs 10 to 12 of the previous office action. In an effort to overcome the previous prior art rejections over Schachter applicants have required the presence of dimethylmalonic acid in the claimed composition. While Schachter teaches a medical apparatus comprising a surface which is coated with a sol-gel composition containing the silanes required by claim 1, patentees do not teach dimethylmalonic acid. Rather, this reference generally teaches acidic catalysts, as well as a pH in the acidic range. See paragraphs 70, 86 and 53.

Clark teaches coating compositions prepared from the hydrolysis of alkoxysilanes. The top of column 3 teaches that optimum properties are obtained by the addition of an acid compound, to function both as a pH adjusting agent and to affect the rate of silanol condensation. This reference teaches the alternative use of many acid compounds such as formic or acetic acid, both of which are taught by Schachter, and dimethylmalonic acid.

It is prima facie obvious to substitute equivalents, motivated by the reasonable expectation that the respective species will behave in a comparable manner or give comparable results in comparable circumstances. The express suggestion to substitute one equivalent for another need not be present to render the substitution obvious.

Thus one having ordinary skill in the art would have found the presence of dimethylmalonic acid in the coating composition of Schachter to have been obvious in view of the teachings of Clark, which indicate the functional equivalence of various

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organic acids. The results of such a substitution would have been predictable, since they are disclosed as being equivalents in lowering pH and effecting the rate of silanol condensation. The Examiner notes, too, that paragraph 68 of Schachter refers to the Clark patent as a manner of teaches partial silanol condensates.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

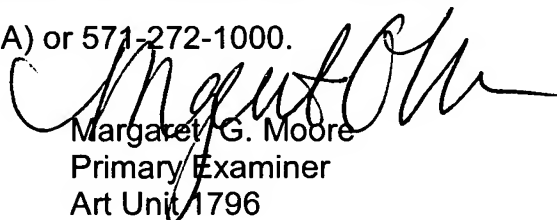
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action..

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday and Wednesday to Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Margaret G. Moore
Primary Examiner
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mgm
1/30/08